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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,604	04/02/2004	Gary L. White	370002-00080 CIP	3127
30954	7590	08/20/2008		
LATHROP & GAGE LC 2345 GRAND AVENUE SUITE 2800 KANSAS CITY, MO 64108			EXAMINER SCHATZ, CHRISTOPHER T	
			ART UNIT	PAPER NUMBER
			1791	
			MAIL DATE	DELIVERY MODE
			08/20/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/817,604

Applicant(s)

WHITE ET AL.

Examiner

CHRISTOPHER SCHATZ

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim requires "performing a curing operation including heating to form the first flowable coloring material and the second flowable material onto a coloring sheet of a substantially solid condition having the first flowable coloring material embedded therein." The specification does not support a curing method wherein heating is performed to form the first and second flowable materials onto a coloring sheet. Rather the specification supports the claim as originally written: "performing a curing operation including heating to form the first flowable coloring material and the second flowable material into a coloring sheet of a substantially solid condition having the first flowable coloring material embedded therein." The examiner has noticed that the applicant replaced the term "into" with the term "onto" in the claims filed on August 13, 2007. Because this amendment did not properly amend the claim, the examiner believes this to be a typographical error. As such, for the purposes of this

office action, the examiner will examine the claim assuming that the applicant intended to use the term "into" instead of "onto," as supported by the specification and original claims.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the examiner how the first flowable and second flowable coloring material can be formed onto a coloring sheet while the first flowable material is embedded therein. As noted above, the examiner believes this to be a typographical error. As such, for the purposes of this office action, the examiner will examine the claim assuming that the applicant intended to use the term "into" instead of "onto," as supported by the specification and original claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Gray, III (US 4327121).

As to claim 1, Gray, III discloses casting one or more lamina including polyvinyl chloride, polyurethane (binder) and pigment onto a strippable sheet to make a transferable printed design, and curing the design. The casting is provided with the surface effect which is the reverse of the release surface. Gray, III. discloses that it is known in the art to impart to the surface of the plastic material the quality of finish of the release surface, such as a textured (matte) surface i.e. employing the texture of the support surface to provide the first surface with a matte finish (col. 1 lines 18-21, col. 2 lines 62-65, col. 4 lines 25-30 and col. 5 lines 10).

It is noted that the flowable initial material is consolidated under heat and pressure; electron beam radiation is only utilized to prepare the support surface (col. 4 lines 5-13).

It is also noted that the flowable material is substantially devoid of flattening agents.

As to claim 2, when a textured base is supplied, the side of the casting that does not contact the base will have a glossier finish (col. 2 lines 60-63). As to claim 5, the method disclosed by Gray, III. produces a strippable sheet (col. 4 lines 29-32).

7. Claims 1, 5 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Spain et al. (US 5203941, cited in IDS).

Spain discloses a method of forming a coloring sheet having a preselected color and being structured to be laminated to a plastic sheet to form a laminated plastic building panel suitable for use on a building, the method comprising: applying a flowable initial material 38 having a polymeric binder and a pigment material (column 6, lines 25-26 and lines 34-35), the binder including a plastisol (polyvinylidene fluoride), the

flowable material substantially devoid of flattening agents, on a textured support surface, such that the flowable initial material is against the textured support surface (column 9, lines 3-15; column 9, line 66 - column 10, line 20; figures 4 and 5); curing the flowable initial material by heating the flowable initial material against the support surface to form a relatively less flowable coloring material disposed on the support surface (column 6, lines 30-37), the coloring material having a first surface and a second surface, the first surface being disposed adjacent the support surface and the second surface being disposed opposite the first surface (figures 4 and 5); and the curing coupled with texture of the support surface to provide the first surface with a matte finish when the coloring material is removed from the substrate (column 9, line 66 – column 10, line 20, figure 1).

As to claim 5, Spain discloses a method wherein said curing the flowable initial material to form a relatively less flowable coloring material disposed on the support surface includes forming the coloring material into a sheet (see figures, column 6, lines 31-40).

As to claim 15, Spain discloses a method of forming a coloring sheet having at least a first preselected color and being structured to be laminated to a plastic sheet to form a laminated plastic building panel suitable for use on a building, the method comprising: applying onto a support surface of a substrate 38 a first flowable coloring material 50 having a polymeric first binder and a first pigment material, the first binder including a plastisol (column 7, lines 2-39); at least partially curing the first flowable coloring material, the at least partially curing including heating, to form a relatively less

flowable first coloring material disposed on the support surface (column 6, lines 54-63); applying onto the substrate in contact with the first flowable coloring material a second flowable coloring material 56 having a polymeric second binder and a second pigment material, the second binder including a plastisol (column 7, lines 2-39); and performing a curing operation including heating to form the first flowable coloring material and the second flowable material into a coloring sheet of a substantially solid condition having the first flowable coloring material embedded therein (column 6, line 54 – column 7, line 62). As to claim 16, Spain discloses performing all of the steps in a single inline process (figure 3). As to claim 17, Spain discloses applying the first coloring material in a predetermined pattern (column 6, lines 60-61).

8. Claims 1, 3, 5 and 15, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellison (US 5985079, newly cited).

Ellison discloses a method of forming a coloring sheet having a preselected color and capable of being structured to be laminated to a plastic sheet to form a laminated plastic building panel suitable for use on a building, the method comprising: applying a flowable initial material 15 having a polymeric binder and a pigment material, the binder including a plastisol (column 6, lines 4-65, figures 1, 2, and 5), the flowable material substantially devoid of flattening agents, on a textured support surface 13, such that the flowable initial material is against the textured support surface (column 2, lines 64-66); curing the flowable initial material by heating the flowable initial material against the support surface to form a relatively less flowable coloring material disposed on the support surface, the coloring material having a first surface and a second surface, the

first surface being disposed adjacent the support surface and the second surface being disposed opposite the first surface (figures 3 and 4); and the curing coupled with texture of the support surface to provide the first surface with a matte finish when the coloring material is removed from the substrate (column 9, lines 30-52).

As to claim 3, Ellison discloses a method wherein the flowable initial material includes plastic particles, said heat the flowable initial material so as to cause fusing together of said plastic particles (column 4, lines 15-20). As to claim 5, Ellison discloses a method wherein said curing the flowable initial material to form a relatively less flowable coloring material disposed on the support surface includes forming the coloring material into a sheet (see figures).

As to claim 15, Ellison discloses a method of forming a coloring sheet having at least a first preselected color and being structured to be laminated to a plastic sheet to form a laminated plastic building panel suitable for use on a building, the method comprising: applying onto a support surface of a substrate 11 a first flowable coloring material having a polymeric first binder and a first pigment material, the first binder including a plastisol (column 8, lines 51-65); at least partially curing the first flowable coloring material, the at least partially curing including heating, to form a relatively less flowable first coloring material disposed on the support surface (column 9, lines 27-31); applying onto the substrate in contact with the first flowable coloring material a second flowable coloring material having a polymeric second binder and a second pigment material, the second binder including a plastisol; and performing a curing operation including heating to form the first flowable coloring material and the second flowable

material into a coloring sheet of a substantially solid condition having the first flowable coloring material embedded therein. Applicant's attention is directed to column 8, lines 37-50, where the reference specifically discloses an embodiment wherein the two difference coloring materials of two different colors (claim 18) are applied in separate steps. As to claim 17, Spain discloses applying the first coloring material in a predetermined pattern (column 8, lines 37-50).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellison, as applied to claim 1 above, and further in view of Ocampo et al. (US 5108836, cited in IDS).

Ellison discloses the limitations with respect to claim 1 as discussed above, and further discloses that the flowable initial material can be applied to a polymer web. It is unclear if the web can be comprised of paper. Ocampo discloses a method of forming a coloring sheet to be laminated to a plastic sheet, wherein said method comprises applying a flowable initial material onto a support surface of a substrate. Ocampo further discloses that said substrate can be comprised of a polymer web, or alternatively, a paper web (column 3, lines 54-57). Therefore, at the time the invention was made, it

would have been obvious to one of ordinary skill in the art to modify the method of Ellison such that the flowable initial material is applied to the surface of a paper web because such a method is a well known alternative to applying the flowable material to a polymer web as taught by Ocampo.

Response to Arguments

9. Applicant's arguments filed June 9, 2008 with respect to Grey have been fully considered but they are not persuasive.

The applicant asserts that Grey does not disclose heat curing. The applicant is referred to column 4, lines 4-7 where Grey discloses curing by heating. Additionally, the applicant is referred to section 7 of the office action dated January 7, 2008. The applicant further argues that Grey does not disclose "the coupling of curing with a textured surface, to eliminate the need for flattening agents". This argument is not commensurate with scope of applicant's claim. Claim 1 only requires that the flowable material be substantially devoid of flattening agents. The examiner asserts that Grey does not disclose flattening agents in the flowable material and thus the reference meets the amended limitation of the claim. As to applicant's arguments directed to the Burgess, Bull and Burnett, such arguments are moot in light of examiner's new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHRISTOPHER SCHATZ** whose telephone number is

571-272-6038. The examiner can normally be reached on Monday through Friday 9 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHRISTOPHER SCHATZ/
Examiner, Art Unit 1791

/Richard Crispino/
Supervisory Patent Examiner, Art Unit 1791